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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/614,584

07/07/2003

Frank Gordon Krausz

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07/21/2006

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EXAMINER

HUYNH, CONG LAC T

ART UNIT

PAPER NUMBER

2178

DATE MAILED: 07/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/614,584		KRAUSZ ET AL.	
	Examiner		Art Unit	
	Cong-Lac Huynh		2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: amendment filed 4/26/06 to the application filed on 7/7/03, priority filed 7/10/02.

2. Claims 14-22 are pending in the case. Claims 14 and 20 are independent claims.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 14-16, 18, 20-21 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Viswanath et al. (US Pat App Pub No 2003/0074271, 4/17/03, filed 10/17/01) in view of Matsakis et al. (US Pat App Pub No 2005/0273772, 12/8/05, priority

12/21/99) and Peat et al., *Introducing XML/EDI... "the e-Business framework"*, August 1997, IDS.

Regarding independent claim 14, Viswanath discloses:

- using a graphical user interface to create a file including tags (figure 2, [0049]-[0058]: via the interface, XML files with tags are created for business purpose in purchasing system that allows users to perform typical customization)
- including XML tags for selecting data for inclusion in the purchase order (([0016]-[0017],[0019]) and specifying a layout for the purchase order including the selected data ([0018], [0021], [0084]-[0086])
- accessing a database of a service provider to collect data according to the tags for using the collected data and generating a purchase output file ([0016]-[0021])
- providing the purchase output file to an output device which uses the purchase output file to generate the purchase order where the data for the purchase order is fetched in response to the user's request and the format is formed suitable for delivery in response to the particular purchase order ([0018], [0021])

Viswanath does not disclose that the xml document is an invoice.

Matsakis discloses using XML format for business documents such as invoices and purchase orders ([0012]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Matsakis into Viswanath for generating an invoice using the same method as in Viswanath since invoices or purchase orders are business

documents including specific data related to invoices or purchase orders. Thus, by analogy, an invoice can be generated using Viswanath method with XML tags and specific data related to an invoice.

Viswanath and Matsakis do not disclose that the tags used for the purchase order or the invoice are the IML tags of the Invoice Markup Language.

Peat addresses that it is surprisingly simple that one can define one's own markup language with XML (page 10).

Therefore, it would have been obvious to an ordinary skill at the time of the invention was made to have combined Peat into Matsakis and Viswanath for the following reason. Matsakis discloses using XML for encoding business documents such as invoices and purchase orders providing the advantage to incorporate into Viswanath method for generating an invoice using XML with specific data relating to invoices as desired instead of data relating to purchase orders.

Further, since defining a particular markup language based on XML for a specific purpose is possible according to Peat, it appears that XML, when applied for generating an invoice, would produce an invoice markup language with specific tags relating to invoice characteristics.

Regarding claim 15, which is dependent on claim 14, Viswanath disclose that the purchase order output file comprises an HTML file [0024].

Matsakis discloses using XML format for business documents such as invoices and purchase orders ([0012]).

Art Unit: 2178

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Matsakis into Viswanath for outputting an invoice file using the same method as in Viswanath since invoices or purchase orders are business documents including specific data related to invoices or purchase orders. Thus, by analogy, an invoice can be generated using Viswanath method with XML tags and specific data related to an invoice.

Regarding claim 16, which is dependent on claim 15, Viswanath discloses transmitting the output file via a network to the output device ([0012], [0017]).

Regarding claim 18, which is dependent on claim 16, Viswanath discloses that the output device comprises a personal computer ([0014], [0015], [0060]).

Claims 20-21 are for a system for performing method claims 14 and 15, and are rejected under the same rationale.

6. Claim 17 remains rejected under 35 U.S.C. 103(a) as being unpatentable over Viswanath in view of Matsakis and Peat as applied in claim 16 above, and further in view of Emmett et al. (US Pat App Pub No 2002/0129006 A1, 9/12/02, filed 2/14/02, priority 2/16/01).

Regarding claim 17, which is dependent on claim 16, Viswanath, Matsakis, and Peat do not disclose that the output device comprises a hand-held processing device.

Emmett discloses that handheld devices including Personal Digital Assistants (PDAs) and cellular telephones offer connectivity to the Internet and permit access to documents available over the Internet ([0005]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Emmett into Viswanath, Matsakis, and Peat since Emmett discloses that a handheld device can access to a document available on the Internet providing the advantage to incorporate into Viswanath, Matsakis, and Peat for having a handheld device as a convenient output device, since a user can carry it with him or her anywhere, for accessing an online invoice, a form of Internet document.

7. Claims 19 and 22 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Viswanath, Matsakis, and Peat as applied in claim 16 above, and further in view of Scolini et al. (US Pat App Pub No 2003/0233321 A1, 12/18/03, filed 10/30/02, priority 11/30/01).

Regarding claim 19, which is dependent on claim 14, Viswanath, Matsakis, and Peat do not disclose that the invoice output file comprises a printer-control language file.

Scolini discloses that the invoice or customer bill is converted into AFP format as the output file ([0842], [0980]).

It would have been obvious to one of ordinary skill in the art at the time of the invention was made to have combined Scolini into Viswanath, Matsakis, and Peat since the AFP form, which is a printer-control language file, of the invoice in Scolini provides the advantage to incorporate into the invoice in Viswanath, Matsakis, and Peat for rapidly printing the invoice document at a printer site.

Claim 22 is for a system for performing method claim 19, and is rejected under the same rationale.

Response to Arguments

8. Applicant's arguments filed 4/26/06 have been fully considered but they are not persuasive.

Applicants argue that the cited references do not disclose using the graphical user interface for creating an invoice.

The Examiner respectfully disagrees.

Viswanath shows the graphical user interface for generating business documents in XML that allows users to perform typical customization (figure 2, [0049]-[0058]).

Generating business documents in XML via a graphical user interface in Viswanath specifying both a page style for the documents and how to display the data within the documents where business documents are known to include purchase orders and invoice as disclosed in Matsakis and where a markup language can be written for a particular purpose from a XML indicates that it is possible to create an invoice with an invoice markup language from XML using a graphical user interface tool.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Price et al. (US Pat App Pub No 2002/0082881).

Bennett et al. (US Pat App Pub No 2002/0116334).


Lee et al. (US Pat App Pub No 2002/0147732).

Jadanovski et al. (US Pat App Pub No 2005/0086291).

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cong-Lac Huynh whose telephone number is 571-272-4125. The examiner can normally be reached on Mon-Fri (8:30-6:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Cong-Lac Huynh
Primary Examiner
Art Unit 2178
07/12/06